

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: DREHER, et al.

Serial No.: 09/482,773

Group Art Unit: 1617

Filed: January 13, 2000

Examiner: YU, Gina C.

For: OPTICAL MAKEUP COMPOSITION

Commissioner for Patents
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RESPONSE TO EXAMINER'S ANSWER

In response to the Examiner's answer of December 7, 2009, to the Appellants' Brief submitted December 9, 2008 and the Appellants Supplemental Appeal Brief submitted on September 17, 2009, appealing from the office action mailed on May 29, 2008, the Appellants provide the following remarks. So as to keep this paper brief, the Appellants have attempted only to address certain remarks made by the Examiner which the Appellants perceive as inaccuracies or misinterpretations.

Remarks

Claim rejections – 35 USC §102

Rejection of claims 1-5, 7, 9 and 11 under 35 USC §102(b) as anticipated by Kimura (US 5,690,916; hereinafter, “US’916”) as further evidenced by Wrinkles and Wrinkle Treatments (www.skin-care-reviews.com; hereinafter, “Wrinkle Treatments”).

Examiner’s Response to Argument

1. The Examiner asserts that the Appellants’ position is that the method disclosed in US’916 and the present method are not necessarily directed to the same population of people in need of such treatments on their skin, and that the Appellants’ argument is not commensurate with the scope of the claims because the claims do not require the user population to be in need of age-associated wrinkle treatment.

The Appellants respectfully point out that the “in need” language is not required here from a legal perspective. Essentially the same limitation is provided by the language “applying to skin exhibiting the age-associated lines and wrinkles”. Technically speaking, in the present case, there is no disease or other serious affliction which would require the “in need” language.

2. The Examiner asserts, because the Appellants “admit” in their specification that the process of aging strikes everyone, and that even young women are more conscious of the early development of lines, that the Appellants suggest that the population of users of the present cosmetic method for camouflaging wrinkles and the population using the cosmetic method for camouflaging a skin hyperpigmentation condition described in the reference are the same since everyone is affected by skin aging.

Appellants have made no such suggestion, and once again point out that the reference fails to disclose or suggest that the application of a composition comprising a blue interference pigment to a blue hyperpigmented area of the skin would have any wrinkle camouflaging effect. The method in the reference concerns applying a composition containing a blue interference pigment to a blue skin discoloration to make it appear the color of the surrounding skin. There is no disclosure or suggestion in the

reference that any aspect of the skin aside from its color is affected. On the other hand, the Appellants' method concerns applying a composition containing a blue interference pigment to skin which is lined and/or wrinkled to make the skin appear to be unlined and unwrinkled; that is, smooth. In fact, there is no connection of blue with wrinkles in the reference.

3. The Examiner asserts that the Appellants allege that the prior art composition was applied to Asian females only, and that such an assertion is inaccurate and a conjecture at best because the reference in fact does not indicate such limitation on the user population. Additionally, the Examiner suggests that the Appellants' position is that the reference method is limited for use on a certain race or gender.

The Appellants have made no such assertions. The Appellants have merely pointed out that the only disclosure in the reference of applying a composition comprising a blue interference pigment to skin concerns the application of the composition to a specific blue skin discoloration referred to as "Ota's nevus". It is a fact that Ota's nevus is a condition which occurs at birth or manifests itself during childhood, and principally in Asian females, well before the appearance any age-associated lines and wrinkles in the skin. While the Examiner cites the Board (See Appeal No. 2007-0627, March 22, 2007) as stating that "application of the makeup composition to the skin of a person 25 to 35 years of age and older is inherent application to skin exhibiting lines and wrinkles", the Appellants maintain that the application of the reference composition to such blue skin discoloration in children, who do not yet manifest age associated lines and wrinkles, does not inherently practice the invention as claimed.

4. The Examiner asserts that the Appellants rely on a presupposition that Asian female skin somehow does not undergo the "normal" progress of skin aging that is described in Wrinkle Treatments, citing a cultural habit of avoiding sunlight, and that the argument is hearsay at best. The Examiner further asserts that the Appellants' position is that Asian female skin is age-proof.

Once again, the Examiner has misinterpreted the Appellants' position. The Appellants do not disagree that skin aging is a natural, inevitable process for all humans. Nevertheless, skin aging does not manifest itself in the same way in all human skins. It first must be appreciated that Wrinkle Treatments does not explicitly define "normal",

but sets out perceived “normal” milestones relative to skin wrinkling. The word “normal” means regular, typical, or usual for a certain group. Nevertheless Wrinkle Treatments does not identify any particular group of persons to which the milestones are applicable. It is well-known to those skilled in the art of cosmetics and skin care that while Caucasians tend toward early wrinkling and later development of age spots on the facial skin, it is just the opposite for Asians. This is particularly true for Asian females, since it is further well-known that Asian woman do tend to avoid sun exposure, in part because they value a whiter and more even-toned complexion. There has been so much literature written on the subject that it cannot be considered hearsay. Since the normal milestones set out in Wrinkle Treatments most likely reflect the occurrences in Caucasian skin, and are highly unlikely to be applicable to the skin of Asian females, it also is highly unlikely that such milestones are applicable to all skin.

For the above reasons, the Appellants maintain that the anticipation rejection has not been properly made, since the presently claimed cosmetic method is not inherently anticipated by the method of cosmetically addressing a specific skin condition as set out in the reference.

Claim rejections – 35 USC §103

Rejection of claims 1-7, 9-11, and 25 under 35 USC §103(a) as being unpatentable over Hineno (US 6,207,174, hereinafter “US’174”) in view of US’916.

Examiner’s Response to Argument

1. It is the Examiner’s position that US’174 teaches the cosmetic utility of using interference pigments, including the use in cosmetic compositions for covering wrinkles and improving skin color, and further teaches the use of compositions containing blue interference pigments, and that US’916 discloses the use of compositions comprising blue interference pigments for camouflaging a blue hyperpigmented portion of the skin. The Examiner further urges that the teaching in US’174 for wrinkle coverage is not limited to the use of compositions containing a red interference pigment, but that

compositions containing the red interference pigment are mere preferred embodiments disclosed in US'174.

Although the Appellants have refuted the Examiner's position in detail in the Appeal Brief, and the Examiner has merely restated her position in her Answer, without more, the Appellants will briefly restate their position. The authors of the reference provided many examples of cosmetic compositions, and had ample opportunity to provide an example of a cosmetic composition for use on the facial skin, including a composition for covering wrinkles, using an interference color other than red, but they did not. Although the Examiner points out that a composition incorporating a blue interference pigment is disclosed in the reference (i.e., Example 10) that composition is not a cosmetic composition of any sort, but an adhesive. That all of the examples in US'174 provided for the purpose of improving skin color and/or camouflaging wrinkles use only a pigment exhibiting a red reflectance is strong evidence that the use of only red interference color in these compositions was intended, and that these examples do not represent mere preferred embodiments, as the Examiner contends, of cosmetic compositions useful for application to the facial skin and lips for improving skin color. Although the Examiner argues that there is no evidence that it is the red tone of the color which imparts the wrinkle covering effect, Appellants urge that a careful reading of the reference would indicate otherwise, as set out in detail above and in the Appellants' Appeal Brief.

The '916 reference discloses the use of red interference pigments in cosmetic compositions for adjusting the color of a red hyperpigmented portion of the skin, and the use of blue interference pigments in compositions for camouflaging a blue hyperpigmented portion of the skin. The '916 reference is completely silent about wrinkles. There is no connection of blue with wrinkles in either reference. Based on the teachings in the '174 reference, which connects red with wrinkles, one skilled in the art would simply not have been guided to substitute a blue interference pigment, as taught in the '961 reference, for the red interference pigment in the compositions of the '174 reference, for covering wrinkles.

2. The Examiner asserts that the Appellants' argument that US'174 fails to suggest that a composition comprising a blue interference pigment would not have any

wrinkle covering effect is not commensurate with their claims, since the claims fail to exclude using red interference pigment, and the amount of blue interference pigment to use relative to the other components is not recited. The Examiner further contends that “at least one metal oxide pigment” is the equivalent of the metal oxide coated mica interference pigments.

The Appellants would urge that the essential point is not what is excluded by the present claims, but what is included. The method recited in the present claims requires the use of a composition which includes an interference pigment having a blue or violet reflectance to camouflage age-associated lines and wrinkles in the skin, and there is no association of blue or violet with lines and wrinkles in US’174 (or in US’916). Moreover, as should be clear from both US’174 and US’916, metal oxide pigments, also called for by the Appellants’ claims, are not the same as metal oxide coated mica (i.e., interference pigments). The amount of the interference pigment to use in practicing the claimed method is clear from the Appellants’ claims.

3. The Examiner comments that the Appellants’ argument that the compositions of the invention comprise no greater than 15%, and preferably no greater than 10% by weight of inorganic powders, is not commensurate with the scope of the present claims, because claims 6 and 35 require “at least one” inorganic, non-matte, non-spherical powder which, the Examiner asserts, does not preclude the presence of other type of inorganic, non-matte spherical powders. The Appellants would urge otherwise.

First, the claim language refers to “non-matte, non-spherical” inorganic powders, and not to inorganic powders, generally. Additionally, the “at least one” language in the claims 6 and 35 makes it clear that more than one type of non-matte, non-spherical inorganic powder may be employed; however, the total amount is limited to no more than 2 to 10% by weight of the total composition, and these types of powders are exemplified in Appellants’ claim 7. Further, the Examiner states that “Appellant compares the claimed composition to Example 13 of Kimura, which, according to appellant, contains 58.8% of inorganic, non-interference pigment powders”. The Appellants wish to point out that it is not they who keep comparing the composition used in the claimed method to Example 13 in US’916, but the Examiner who has repeatedly pointed out this specific example in many office actions. The Examiner, in her Answer, again points to further

specific examples: 2, 6, and 7 in US'174, noting that each of examples 2 and 6 disclose compositions containing relatively low levels of sericite, and that the composition of Example 7 contains iron oxides, and concludes that the limitation in the Appellants' claims relative to the amount of non-matte, non-spherical inorganic powder does not render the claims nonobvious.

The Appellants point out that the compositions of Examples 2 (loose powder) and 6 (emulsified foundation) both contain a red interference pigment. The composition of Example 7 is directed to an eyeshadow (not a foundation, as noted by the Examiner) and contains a green interference pigment and no metal oxide. Whether or not these examples contain relatively low amounts of powders, none of these includes components which meet the essential features of the Appellants' claims which include a blue- or violet- reflecting interference pigment in combination with at least one metal oxide pigment.

4. It is the Examiner's position that, as compositions comprising interference pigments have been known for use in the industry, the skilled artisan would have a reasonable expectation of efficacy, from the cited references, of covering any skin defects, such as wrinkles.

Nevertheless, as Appellants have stated in their Appeal Brief, the claims at issue are directed toward a specific use of a specific type of interference pigment and not to a general use of interference pigments in disguising any kind of skin flaws. The Examiner broadly interprets both references as teaching that any interference color may be used in the compositions for any purpose. However, a careful reading of each of the references will show that there is nothing in those references which would lead one skilled in the art to believe that any composition can be utilized for any purpose.

As there is no motivation in either of the cited references to substitute a blue reflecting interference pigment, as taught by US'916, for the red reflecting interference pigment in the cosmetic compositions in US'174, for the purpose of camouflaging age-associated lines and wrinkles in the skin, and the Examiner has used only hindsight reconstruction in an attempt to arrive at the Appellants' invention, the Examiner has not established *prima facie* obviousness of the invention.

Rejection of claim 8 under 35 USC §103(a) as being unpatentable over US'916 and US'174, as applied to claims 1-7, 9-11, and 35, and further in view of Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993, hereinafter "Hurst").

Examiner's Response to Argument

1. The Examiner's position is that the Appellants' argument does not take into account the specific teaching in Hurst of the motivation for a skilled artisan to employ bismuth oxychloride (i.e., a non-matte, non-spherical inorganic powder of the Appellants' claims) – to enhance the "natural", not glossy, complexion of the skin. The Examiner further asserts that the Appellants' argument is not commensurate with the scope of the claims because the claimed method does not prevent the application of extra layers of cosmetics over the skin coated with the composition of the present claims to produce the maximum natural appearance.

The Appellants would urge that, although, the Examiner is misinterpreting the teachings in both the Hurst reference and US'916, the point is that the mere disclosure of bismuth oxychloride in the Hurst reference, when the primary elements of the claims have not been shown to be either anticipated by or obvious from the '174 and '916 references, cannot then itself render the claims obvious. The combination of the '174 and the '916 references is inadequate to support the rejection of claim 8, since at least one primary element of claim 1, to which claim 8 is appended, is not anticipated by or made obvious from the references. Specifically, both references fail to teach the essential step of applying to the skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment, to visibly reduce the appearance of wrinkles or lines in the skin caused by aging.

Secondarily, while it is not contested that Hurst discloses that bismuth oxychloride may be used in powders to provide luster to enhance the complexion, US'916 teaches against using bismuth oxychloride as indicated by Hurst, since it is disclosed throughout the '916 reference, at for example, column 17, lines 19-25, column 20, lines 34-39, and column 22, lines 18-23, that, after the application to hyperpigmented skin of the composition containing the titanium dioxide coated mica (the interference pigment) a conventional foundation was

applied over the hyperpigmented and the normal areas of the skin. This was done to temper or modulate the gloss of the titanium oxide coated mica to result in a natural transparent finish comparable to normal skin. In view of the teachings in US'916, the Appellants urge that one skilled in the art simply would not perceive the benefit of needing to apply more layers of makeup. For the above reasons, the Appellants maintain that the Examiner has not established *prima facie* obviousness of claim 8.

CONCLUSION

In light of the arguments presented herein, and in the Appellants Brief, the anticipation rejection of claims 1 to 5, 7 and 9 to 11, based on the '916 reference, the obviousness rejection of claims 1 to 7, 9 to 11 and 35, based on the '174 reference in view of the '916 reference, and the obviousness rejection of claim 8 in view of the aforementioned references, further in combination with the Hurst reference, should be reversed as they are unfounded.

Accordingly, the Appellants again respectfully request that the Honorable Board reverse the decision of the Examiner finally rejecting the pending claims and declare that claims 1 to 11 and 35 in this application are allowable.

Respectfully submitted,

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